



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/712,935

11/12/2003

Mark M. Kotik

PREDYN-44227

9890

26252

7590

10/19/2005

KELLY LOWRY & KELLEY, LLP
6320 CANOGA AVENUE
SUITE 1650
WOODLAND HILLS, CA 91367

EXAMINER

NGUYEN, KIMBERLY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,935

Applicant(s)

KOTIK ET AL.

Examiner

Kimberly D. Nguyen

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-47 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Acknowledgement is made of Amendment filed August 4, 2005.

Additional Remarks

2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the De La Huerga's U.S. Publication No. US 2002/0084904 reference, which claims the benefit of earlier date back to December 20, 1996, to either a constructive reduction to practice or an actual reduction to practice. Applicants' Declaration under 37 CFR 1.131 (filed August 4, 2005) claims that "As shown in Exhibit A, we conceived of the identification band with adhesively attached coupling elements set forth in the specification and claims of application, Serial No. 10/712,935, at least as early as early 1996." ... "Further, as shown in Exhibit F, in October 1999, our reduction to practice continued as we were designing electronic circuits to achieve the inventive concept. The circuit including a diode as shown was contemplated as achieving a fast switch device without designing new materials. (Exhibit F)" (see paragraph 6 of page 3 through paragraph 11 of page 5). However, no sufficient diligence is shown between October 1999 and the filing date of the parent application, which is March 18, 2002.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2876

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-22 and 24-47 are rejected under 35 U.S.C. 102(e) as being anticipated by De La Huerga (US 2002/0084904).

Re claims 1-3, 5, 15, 17-21, 30, 32-35, 37-42, and 46-47: De La Huerga teaches an identification band (figs. 1-2), including:

an elongated flexible strap (bracelet 104) having a head end and a tail end (first and second ends 106 and 108 in fig. 2; paragraph 103);

a communication circuit (figs. 3-5) carried by the strap (paragraphs 38, 107), the communication circuit including a pair of electronic coupling elements (1311, 1313 in fig. 17) disposed generally at the strap head and tail ends (paragraphs 161, 103); and

an adhesive for securing the strap head and tail ends (106, 108) in overlapping relation with the pair of electronic coupling elements in mutually coupled relation, to configure the strap into a closed loop shape of selected circumferential size (“...the ends may be secured via adhesive, melting, crimping, etc”; paragraph 103) (“...the glue strips 1319 secure the ends together...” paragraphs 162, 193-195);

at least one of the electronic coupling elements being physically altered in response to attempted forced separation of the adhesively secured strap head and tail ends to correspondingly alter at least one characteristic of the communication circuit (“...the strap cannot be broken or cut without opening the short circuit...” paragraph 50) (“...If the strap is no longer attached to the patient one of several different functions occur, the several different functions including: erasing the memory, prohibiting reprogramming and access to the memory...” paragraph 59), (“The memory device is integrally embedded in the strap and cannot be removed from the strap

Art Unit: 2876

without destroying the device.” paragraph 38) (paragraphs 38, 51-61, 103-117, 149, 162 and 179-181)..

Re claims 4, 22, and 36: De La Huerga teaches the bracelet (104) is formed of a tear resistant plastic material, which is a dielectric material.

Re claims 6: De La Huerga teaches “...the surfaces 1325 and 1112 are pressed together so that the glue strips 1319 secure ends together...” (paragraphs 162, 228-229), which is the glue strip is a pressure sensitive adhesive.

Re claims 7 and 12-13: De La Huerga teaches, for example, “the plates 358 and 360 overlay and are separated by a thin layer of plastic band material there between...” (paragraphs 228-229), wherein the thin layer serves as a protective film mounted over at least a portion of the communication circuit.

Re claims 8 and 24: De La Huerga teaches the identification device (fig. 15) having a transmitter, an RF antenna, etc, to communicate with a remote reader (300 in fig. 6) (paragraph 223).

Re claims 9, 14, 16, 26, 29, 31, and 43: De La Huerga teaches “...when ends 354 and 356 are secured (e.g., glued via an adhesive) together, plates 358 and 360 are close enough to form a capacitive coupling such that a complete loop is formed by the device components including the capacitive coupling between plates 358 and 360...” (paragraphs 228-229 and 161-164, figs. 34-35), wherein the capacitive coupling plates 358 and 360 serve as a pair of capacitor plates.

Re claims 10-11, 27-28, and 44-45: De La Huerga teaches one of the capacitor plates has a predetermined area, and wherein the other of the capacitor plates has a length greater than the length of the one capacitor plate (figs. 17 and 19-20; paragraphs 161-1634).

Re claim 25: De La Huerga teaches the electronic coupling elements comprising conductive films printed onto the flexible strap (see 116 in fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga in view of Harilela (US 4,862,436). The teachings of De La Huerga have been discussed above.

De La Huerga fails to specifically teach or fairly suggest a peel-off strip protectively covering the patch.

Harilela teaches a strap (14) having pads (10, 11) for fastening the strap to a wearer's wrist, wherein each pad (10, 11) has an adhesive backing with a peel-off protection layer 20 (figs. 4-5; col. 2, lines 38-55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the well-known adhesive backing with a peel-off protection layer as taught by Harilela to the teachings of De La Huerga due to the fact that one does not have to retreat a glue and/or adhesive means to secure the two ends of the wrist strap as taught by De La Huerga but rather peel off the protection layer and secure the two ends of the wrist strap as pre-made by the manufacturer. Furthermore, De La Huerga teaches the means (e.g., glue or an adhesive to secure the two ends of the wrist strap), therefore, one of ordinary skill in the art

Art Unit: 2876

would have recognized the necessity to employ the peel-off protection layer to protect the adhesive/glue layer from being damaged by the dust, scratches, or being dried-up, etc.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

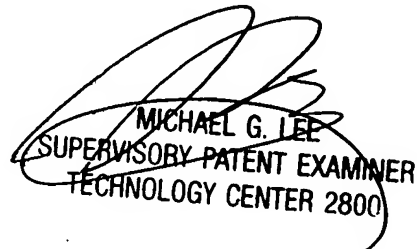
Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN
October 13, 2005



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800